IN THE

Supreme Court of the United States

OCTOBER TERM, 1978

No. 78-1477

FORMICA CORPORATION,

Petitioner,

v.

SAUL F. LEFKOWITZ, DAVID J. KERA and JANET E. RICE, Members, Patent and Trademark Office Trademark Trial and Appeal Board, AND FEDERAL TRADE COMMISSION,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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March 26, 1979

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CITATIONS

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

The petitioner, Formica Corporation, respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals entered in this proceeding on January 25, 1979.

Opinion Below

The opinion of the Court of Customs and Patent Appeals, reported at 200 U.S.P.Q. 641 (1979), appears in the Appendix hereto.

The decision of the Trademark Trial and Appeal Board, vacation of which was sought in the proceeding before the Court of Customs and Patent Appeals, is captioned *Federal Trade Commission* v. *Formica Corp.* and is reported at 200 U.S.P.Q. 182 (1978).

Jurisdiction

The judgment of the Court of Customs and Patent Appeals was entered on January 25, 1979. This petition for certiorari was filed within 90 days of that date. This Court's jurisdiction is invoked under 28 U.S.C. § 1256.[1]

Question Presented

Whether the Court of Customs and Patent Appeals erred in holding that mandamus could not issue to correct a jurisdictional ruling of the Trademark Trial and Appeal Board involving novel and important questions of "pure law" in any case in which a "rational and substantial legal argument" could be made on both sides of the controversy.

Statutory Provision Involved

United States Code, Title 28

> *§ 1651, Writs*
> (a) The Supreme Court and all courts established by Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law.

Statement Of The Case

This mandamus proceeding arises out of a trademark cancellation proceeding brought against Formica Corporation by the Federal Trade Commission.

On May 31, 1978, the Federal Trade Commission filed a petition in the Trademark Trial and Appeal Board of the United States Patent and Trademark Office ("TTAB") to cancel Trademark No. 421,496 for the trademark "FORMICA". That cancellation petition, assigned Cancellation

1. It is now clearly established that this Court has jurisdiction to grant a writ of certiorari running to the Court of Customs and Patent Appeals. Brenner v. Manson, 383 U.S. 519 (1966).

No. 11,955, described the "FORMICA" trademark as having been registered under the Trademark Act of 1905 and republished under § 12(c) of the Lanham Act of 1946 (15 U.S.C. § 1062(c)), and sought cancellation of the mark under § 14 of that Act (15 U.S.C. § 1064), alleging that the "FORMICA" trademark was "registered on the principal register established by the Lanham Trademark Act and has become the common descriptive name of the articles and substances included in [Formica Corporation's] description of goods." *Federal Trade Commission* v. *Formica Corp.*, 200 U.S.P.Q. at 186.

Formica Corporation moved to dismiss the cancellation proceeding on the ground that since the Federal Trade Commission's power to challenge trademarks was limited to trademarks registered on the principal register established by the Lanham Act, the FTC had no standing to apply for cancellation of trademark registrations, including registration of the "FORMICA" mark, made under acts prior to the Lanham Act. On November 8, 1978, the TTAB, expressly overruling the only precedent, *Federal Trade Commission* v. *Elder Mfg. Co.*, 84 U.S.P.Q. 429 (Comm'r 1950), denied Formica Corporation's motion to dismiss. *Federal Trade Commission* v. *Formica Corp.*, *supra.*

Two weeks later Formica Corporation brought the present action, a petition for a writ of mandamus or prohibition, in the United States Court of Customs and Patent Appeals ("CCPA"). That petition sought a writ, directed to respondents Lefkowitz, Kera and Rice as members of the TTAB, requiring them to vacate their opinion and order of November 8, 1978 and to dismiss the cancellation proceeding for lack of jurisdiction. The question raised by the mandamus petition was whether as a matter of law the TTAB was correct in overruling the only precedent and holding that a trademark registered under the 1905 Act and republished under the Lanham Act is a trademark

registered on the principal register established by the Lanham Act.

On December 12, 1978 the Federal Trade Commission, which had been joined as a party to the mandamus proceeding, filed a "Notice of Election" and an affidavit stating that any present, or future, review of any decision of the TTAB, in the cancellation proceeding against Formica Corporation, would be conducted in a United States District Court pursuant to Section 21(b) of the Lanham Act (15 U.S.C. § 1071(b)) and thus would not be reviewable by appeal to the CCPA. The Federal Trade Commission and the individual respondents then moved for dismissal of the petition for mandamus on the ground that this "election" by the FTC ousted the CCPA of jurisdiction.

On January 25, 1979, though sustaining its jurisdiction over this controversy, the CCPA expressly declined to reach the merits of the legal question petitioner sought to have reviewed, denying mandamus before even receiving respondents' replies on the merits of the mandamus petition. See Appendix, pp. A9-A15. The CCPA declined to reach the merits, and denied the petition for mandamus, in the belief that it was legally barred from issuing a writ of mandamus or prohibition in any case in which a "rational and substantial legal argument" could be made on both sides of the controversy.

Reasons For Granting The Writ

The Court of Customs and Patent Appeals in this case, and the Courts of Appeals generally, continue to struggle to establish a rational and workable standard upon which to decide petitions for mandamus directed to the lower courts. Perhaps the best statement of the need for further guidance from this Court is found in Judge Friendly's opinion in *Kaufman* v. *Edelstein,* 539 F.2d 811 (2d Cir. 1976):

> That [the law concerning mandamus] has departed in some degree [from the decisions in *U.S. Alkali*[2] and *De Beers*[3]] is clear enough; what is unclear is how far. Probably this cannot be completely determined until the [Supreme] Court speaks again; there is an obvious tension between the final judgment rule and increased use of the prerogative writs to review orders that are interlocutory even in light of *Cohen,*[4] which must be resolved on a more principled basis than how much a court of appeals disapproves the district court's ruling in the particular case. *Id.* at 817.

Judge Friendly's conclusion that guidance from this Court is much needed is, petitioner respectfully submits, well taken.

The uncertainty and conflict found in the decisions of the Courts of Appeals can be traced to how, or whether, each circuit has attempted to implement this Court's decisions in *Schlagenhauf* and *La Buy, infra.* The Courts of Appeals' varied responses to the teachings of those two cases have led to the use of at least three different tests to determine under what circumstances a writ of mandamus will issue. (Point II, below).

Petitioner submits that this action presents an excellent framework for review of this obviously difficult matter. Here, because of the extremely restrictive standard employed by the CCPA in denying mandamus, the CCPA did not reach the merits of the jurisdictional question to which the mandamus petition was addressed. Thus, unlike most mandamus cases, this case comes before this Court unencumbered by disputed facts or extraneous issues of law.

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2. United States Alkali Export Ass'n v. United States, 325 U.S. 196 (1945).

3. De Beers Consolidated Mines, Ltd. v. United States, 325 U.S. 212 (1945).

4. Cohen v. Beneficial Industrial Loan Corp., 337 U.S. 541 (1949).

The only question raised by this petition for certiorari is whether the CCPA employed an erroneous legal standard when it held that new, unsettled or difficult questions of law relating to a trial court's jurisdiction cannot be reviewed by mandamus (Point I, below). That standard cannot be reconciled with decisions in at least five circuits (Point II, below) and, petitioner respectfully submits, the CCPA's decision should now, in any event, be rejected on its merits (Point III below). Guidance from this Court is necessary if uniformity among the circuits is to be obtained.

I.

THE SOLE QUESTION RAISED BY THIS PETITION FOR CERTIORARI IS WHETHER THE CCPA'S DENIAL OF MANDAMUS RESTED ON AN ERRONEOUS LEGAL STANDARD

The TTAB, as previously noted, denied petitioner's motion to dismiss, which motion had rested "on the ground 'that the FTC is without statutory authority to bring the instant cancellation proceeding'" (Appendix, p. A2) and, therefore, the TTAB must dismiss for want of jurisdiction (Appendix, pp. A10-A11). Petitioner sought review by mandamus.

That mandamus petition brought to the fore the TTAB's own reservations about its decision. Thus, the TTAB members, while unsuccessfully moving to dismiss the mandamus petition on a technical ground (see Appendix, p. A9, n.6), in fact made it clear to the CCPA that they would welcome immediate review of the question of their jurisdiction to hear the cancellation proceeding. The TTAB members' brief states:

> In view of the issue presented on the merits by the PETITION, it would appear that *this case might well be a proper case to reach the question of whether the TTAB does have jurisdiction over the subject matter* even though no final decision has been rendered by the TTAB in the cancellation proceeding.[2]
>
> 2. The [CCPA] is hereby advised that *respondents* Lefkowitz, Rice and Kera, sitting as a board pursuant to 15 U.S.C. § 1067, *would like to have "certified" the question of the board's jurisdiction over the cancellation proceeding to a federal court* had there been statutory or other authority to do so. Compare 28 U.S.C. §§ 1254(3), 1255(2), and 1292(b). See also *Lehman Bros.* v. *Schein*, 416 U.S. 386 (1974). (emphasis added) (TTAB Brief, dated 12/12/78, p. 4).

The TTAB members' brief goes on to argue that the law supports CCPA review of the TTAB's decision by mandamus, and cites four cases as supporting the CCPA's review power. *United States Alkali Export Ass'n* v. *United States, supra*; *In re Metropolitan Trust Company of the City of New York*, 218 U.S. 312 (1910); *Blaski* v. *Hoffman*, 260 F.2d 317 (7th Cir. 1958), *aff'd*, 363 U.S. 335 (1960); and *United States* v. *Boe*, 543 F.2d 151 (CCPA 1976). (TTAB Brief, dated 12/12/78, p. 4).

However, petitioner, and the TTAB, did not obtain a review on the merit because the CCPA *sua sponte* concluded that a twenty-five year old line of cases[5] precluded it from

5. This line of cases began with American Airlines, Inc. v. Forman, 204 F.2d 230, 232 (3rd Cir. 1953) and continued through Pfizer, Inc. v. Lord, 522 F.2d 612, 615 (8th Cir. 1975), *cert. denied*, 424 U.S. 950 (1976) and American Fidelity Fire Insurance Co. v. United States District Court, 538 F.2d 1371 (9th Cir. 1976). It should be noted however, that the Ninth Circuit has since abandoned the *American Airlines* case. Bauman v. United States District Court, 557 F.2d 650 (9th Cir. 1977); United States v. Sherman, 581 F.2d 1358 (9th Cir. 1978). See Point II-B, below.

issuing a writ of mandamus in any case that turns on a hard question of law. (Appendix, p. A12).

The CCPA found that the TTAB's decision turned on *"a pure question of law involving no disputed facts"* (emphasis in original; Appendix, p. A9, n.6). Based on the CCPA's own research, it found that "there was some indication" that respondents' view was correct, and found that there was only one decision on point, *Federal Trade Commission* v. *Elder Mfg. Co., supra,* that "[n]o court has ever passed on this issue" (Appendix, p. A13), and that the legislative history was ambiguous.

The CCPA opinion then quotes as the basis for its decision the test articulated in *American Airlines:*

> *If a rational and substantial legal argument can be made in support of the questionable* [sic] *jurisdictional ruling, the case is not appropriate for mandamus.* . . . (emphasis supplied by the CCPA; Appendix, p. A12).

On that basis the CCPA concluded that it could not properly consider the case on the merits, saying:

> Where, as here, the law at the time of the hearing on Formica Corporation's motion was in such an *unsettled state,* the issue was definitely one for which "a rational and substantial legal argument [could have been] made" in support of either position. We *cannot fault the TTAB* for deciding the motion to dismiss as it did under these circumstances.
> (emphasis added; Appendix, p. A14).

Petitioner submits that the CCPA decision misses the point of the mandamus decisions rendered by this Court since the Third Circuit's 1953 *American Airlines* decision. No one was asking the CCPA to find fault with the TTAB. The CCPA was simply being asked to give guidance to a lower court on an undecided question of law.

Yet the CCPA read decisions of the Third and Eighth Circuits as precluding it from reaching the merits of the mandamus petition once it concluded that colorable arguments could be made on each side of the case. Thus the CCPA denied mandamus, not because it thought the TTAB was correct, nor because it believed that appeal provided an adequate means of review,[6] nor even because in an exercise of discretion the CCPA felt it better not to disturb the decision below.

The CCPA decision presents a clearly articulated standard based on a concise and undisputed record. The CCPA plainly held that it *could not* grant mandamus once it was established that each side's attorneys were sufficiently creative to construct plausible arguments in support of their clients' claims. This holding by the CCPA clearly conflicts with the law of at least five circuits, and, petitioner submits, could not in any event be a proper test for determining whether an appellate court has the power to grant mandamus.

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6. If this case must be tried to judgment before the TTAB, the FTC has stated that, regardless of outcome, rather than take (or allow) an appeal to the CCPA it will force a trial *de novo* in a district court. Thus, assuming that the FTC adheres to this position, after a full trial on the merits the parties will be before a district court, on a motion to dismiss, on exactly the same grounds now presented to the TTAB and CCPA, but with the difference that the district court would be able to certify the question pursuant to 28 U.S.C. § 1292(b) or, failing that, as will appear below, in at least four circuits the Courts of Appeals would almost certainly consider a mandamus petition on the merits.

It should also be noted that Commissioner Dixon of the FTC has publicly stated that the FTC expects to bring more trademark cancellation proceedings. See 68 Trademark Rptr. 469-70 (1978). Thus, absent review of the underlying question by mandamus, there is a real prospect of several more cancellation proceedings being brought before any Article III court decides whether the FTC has the legal power to bring such actions.

II.

THERE IS A CLEAR AND SUBSTANTIAL CONFLICT BETWEEN THE CIRCUITS ON WHAT LEGAL STANDARD SHOULD BE USED IN MANDAMUS CASES

The various federal appellate courts use at least three, quite different, tests in determining whether mandamus should issue. These differing tests are:

A. *The Test Used by the CCPA, Third and Eighth Circuits.*

The CCPA, in this action, the Eighth Circuit and, apparently, the Third Circuit continue to stand behind the quarter-century-old test enunciated in *American Airlines, Inc.* v. *Forman,* 204 F.2d 230, 232 (3rd Cir. 1953)[7] which precludes review by mandamus of any question that can be seriously argued by both sides. Of the tests used by the various circuits, the one adopted by the CCPA employs the most restrictive interpretation of this Court's pre-1953 mandamus cases and fails to take account of this Court's decisions in *Schlagenhauf*[8] and *La Buy.*[9]

Nevertheless, this test was used by the CCPA in denying mandamus in this action, and it is clearly the current law in the Eighth Circuit, *Stein* v. *Collinson,* 499 F.2d 91, 94 (8th Cir. 1974) and *Pfizer, Inc.* v. *Lord,* 522 F.2d 612, 615 (8th Cir. 1975), *cert. denied,* 424 U.S. 950 (1976).[10] The Third Circuit has not overruled the *American Airlines* test,

7. As appears above at p. 8, this test was quoted in, and formed the basis for, the CCPA's January 25, 1979 opinion and judgment herein. See Appendix, p. A12.

8. Schlagenhauf v. Holder, 379 U.S. 104 (1964).

9. La Buy v. Howes Leather Co., 352 U.S. 249 (1957).

10. The denial of mandamus was not called into question by that petition for certiorari.

but neither has it applied the test recently, so its status in that circuit is in doubt. *See Rodgers* v. *United States Steel Corp.,* 508 F.2d 152, 161 (3rd Cir.), *cert. denied,* 423 U.S. 832 (1975); *Rodgers* v. *United States Steel Corp.,* 536 F.2d 1001, 1006 (3rd Cir. 1976).

B. *The Test Used by the Ninth Circuit.*

Reacting to the intervening decisions of this Court, the Ninth Circuit has turned away from the *American Airlines* test,[11] and adopted a set of five "guidelines" for use in mandamus cases:

> (1) The party seeking the writ has no other adequate means, such as a direct appeal, to attain the relief he or she desires. . . .
>
> (2) The petitioner will be damaged or prejudiced in a way not correctable on appeal. (This guideline is closely related to the first.) . . .
>
> (3) The district court's order is clearly erroneous as a matter of law. . . .
>
> (4) The district court's order is an oft-repeated error, or manifests a persistent disregard of the federal rules. . . .
>
> (5) The district court's order raises new and important problems, or issues of law of first impression. . . .
>
> (citations omitted) *Bauman* v. *United States District Court,* 557 F.2d 650, 654-55 (9th Cir. 1977).

See United States v. *Sherman,* 581 F.2d 1358, 1361 (9th Cir. 1978).

Even the Ninth Circuit, however, confesses that in reality these guidelines fail to provide much direction. "The

11. The *American Airlines* test was last followed by a panel of the Ninth Circuit in 1976. American Fidelity Fire Insurance Co. v. United States District Court, 538 F.2d 1371, 1374 (9th Cir. 1976).

considerations are cumulative and proper disposition will often require a balancing of conflicting indicators." *Bauman* v. *United States District Court,* 557 F.2d at 655. Indeed, the Ninth Circuit's indicators must often conflict since, as is the situation here, the case will be rare indeed in which a trial court can be said to have been "clearly erroneous as a matter of law" (guideline 3) concerning a question so unsettled as to be fairly called "new" or one of "first impression" (guideline 5).

C. *The Test Used by the District of Columbia, First, Second, and Sixth Circuits.*

The District of Columbia, First, Second and Sixth Circuits have for their part adopted loosely defined standards which, though lacking the precise articulation of the CCPA, Third, Eighth and Ninth Circuit tests, do strive for a rational basis for decisions on mandamus petitions. Because the phrasing of the criteria used by these courts varies considerably, it is instructive to look at several of these decisions. The District of Columbia Circuit has said:

> In particular, the Supreme Court in *Schlagenhauf,* [*supra*], held that mandamus would lie to review an *"issue of first impression"* in order to *"settle new and important problems."* *Schlagenhauf* involved an issue of discovery, an issue clearly outside the normal class of errors reviewable under mandamus. However, it did involve an *issue of pure law*—even assuming the facts as the District Court perceived them to be, did the District Court have discretion to act or refuse to act as it did. *Schlagenhauf* authorizes departure from the final judgment rule when the appellate court is convinced that resolution of an important, undecided issue will forestall future error in trial courts, eliminate uncertainty and add importantly to the efficient administration of justice. (emphasis added; footnote omitted) *Colonial Times, Inc.* v. *Gasch,* 509 F.2d 517, 524 (D.C. Cir. 1975).

In *United States* v. *United States District Court,* 444 F.2d 651 (6th Cir. 1971), *aff'd,* 407 U.S. 297 (1972), the federal government sought mandamus. In holding that the mandamus petition should be decided on its merits the Sixth Circuit pointed to the underlying importance of the question in dispute, and then went on:

> If this were not enough to occasion our deciding this case on the merits rather than on procedural grounds, it also clearly appears that the issue posed here is a basic issue which has *never been decided at the appellate level by any court. It has been decided favorably to the government's position by two District Courts and adversely to the government by two others.* The Courts of Appeals have the power to review by mandamus "an issue of first impression," *Schlagenhauf* v. *Holder,* 379 U.S. 104, 110, 85 S.Ct. 234, 13 L.Ed.2d 152 (1964), involving a "basic and undecided problem." *Id.* at 110, 85 S.Ct. 234.[12] (emphasis added; footnote omitted) 444 F.2d at 655-56, *aff'd,* 407 U.S. 297, 301 & n.3 (1972).

More succinctly stated, "usurpation of power, clear abuse of discretion, and the presence of an issue of first impression," *Kaufman* v. *Edelstein,* 539 F.2d 811, 819 (2d Cir. 1976) (quoting from *American Express Warehousing, Ltd.* v. *Transamerica Insurance Co.,* 380 F.2d 277, 282-83 (2d Cir. 1967)), are all held to be factors favoring review by mandamus. *See Miller* v. *United States,* 403 F.2d 77, 79

12. Similar considerations caused the Fifth Circuit to resolve, on petition for mandamus, the merits of a novel issue concerning the construction of Rule 16 of the Federal Rules of Criminal Procedure, United States v. Hughes, 413 F.2d 1244, 1247-49 (5th Cir. 1969), *vacated and remanded as moot sub nom.* United States v. Gifford-Hill-American, Inc., 397 U.S. 93 (1970). However, the law on this question appears to be unsettled in the Fifth Circuit as well as in the Fourth. Compare Belcher v. Grooms, 406 F.2d 14, 16-17 (5th Cir. 1968) with Sanders v. Russell, 401 F.2d 241, 243-44 (5th Cir. 1968). *See* General Tire & Rubber Co. v. Watkins, 326 F.2d 926, 928 (4th Cir.), *cert. denied,* 377 U.S. 909 (1964); Holub Industries, Inc. v. Wyche, 290 F.2d 852, 855-56 (4th Cir. 1961); *but see* Ellicott Machine Corp. v. Modern Welding Co., 502 F.2d 178, 181 n.5 (4th Cir. 1974).

(2d Cir. 1968); *United States* v. *DiRusso*, 548 F.2d 372 (1st Cir. 1976); *In re Ellsberg*, 446 F.2d 954, 955-57 (1st Cir. 1971); *Nixon* v. *Sirica*, 487 F.2d 700, 708 (D.C. Cir. 1973); *In re April 1977 Grand Jury Subpoenas*, 573 F.2d 936, 940-41 (6th Cir. 1978); *but see Bancohio Corp.* v. *Fox*, 516 F.2d 29, 32-33 (6th Cir. 1975).[13]

Thus it appears that to the CCPA and the Third and Eighth Circuits, presence of an unresolved question, a difficult question, or a question of first impression *precludes* review by mandamus. The Ninth Circuit's own guidelines are in conflict on whether unresolved, difficult or new issues should militate in favor of or against review by mandamus, while the District of Columbia, First, Second and Sixth Circuits hold that the Courts of Appeals should favor review by mandamus of significant, unresolved legal questions.

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13. Nor are the views of the major commentators any more consistent than the views of the various circuits. Compare 9 Moore's Federal Practice ¶ 110.28 at 308 (2d ed. 1975); 16 C. Wright, A. Miller, E. Cooper and E. Gressman, Federal Practice and Procedure § 3934 at 234-35 (1977); and P. Bator, P. Mishkin, D. Shapiro and H. Wechsler, Hart and Wechsler's The Federal Courts and the Federal System at 1570-71 (2d ed. 1973), which ends one section of its discussion of mandamus with this question: "Should an effort be made to devise a simpler and more intelligible set of standards for determining when review may be had?"

To that rhetorical question, petitioner suggests that the answer must be "yes", particularly in view of the rapid expansion in the number of mandamus cases now being heard by the Courts of Appeals. *E.g.*, in 1956, 49 original proceedings (virtually all such proceedings appear to be applications for writs of mandamus or prohibition, *see* Hart and Wechsler, *supra* at 1572) were brought in in the Courts of Appeals; by 1976, that number had increased elevenfold, to 537. 1957 Annual Report of the Director of the Administrative Office of the United States Courts, p. 164 (1957); 1977 Annual Report of the Director of the Administrative Office of the United States Courts, p. 305 (1977). It is thus apparent that mandamus petitions represent a significant, and growing, portion of the appellate courts' workloads.

Rarely will a clearer, or older, conflict between the circuits appear in this Court. Petitioner respectfully submits that this conflict can, and should, now be resolved.

III.

THE BASIS UPON WHICH THE CCPA DENIED MANDAMUS WAS CLEARLY ERRONEOUS

As the CCPA's opinion points out (Appendix, p. A10), this Court recently reaffirmed in *Thermtron Products, Inc.* v. *Hermansdorfer*, 423 U.S. 336, 352 (1976), its position that:

> The traditional use of the writ in aid of appellate jurisdiction both at common law and in the federal courts has been to confine an inferior court to a lawful exercise of its prescribed jurisdiction or to compel it to exercise its authority.
> *Roche* v. *Evaporated Milk Ass'n*, 319 U.S. 21, 26 (1943).

Confining the TTAB to a proper exercise of its jurisdiction is precisely what the CCPA was asked to do in this proceeding. There can be no doubt, indeed the CCPA expressed none, that the legal issue underlying the mandamus petition—that is, whether the TTAB has jurisdiction over the trademark cancellation proceeding—is of the sort that is properly, and regularly, reviewed by mandamus. Thus the question shifted in the CCPA's opinion, as it does here, from whether—to when—mandamus should issue to restrict a lower court to a proper exercise of its jurisdiction.

The decision in *La Buy* v. *Howes Leather Co.*, 352 U.S. 249 (1957) articulated this Court's view

> that supervisory control of the District Courts by the Courts of Appeals is necessary to proper judicial

> administration in the federal system. The All Writs Act confers on the Courts of Appeals the discretionary power to issue writs of mandamus [in that case to force the district court to try antitrust cases rather than refer them to a master].
> 352 U.S. at 259-60.

In *Schlagenhauf* v. *Holder,* 379 U.S. 104 (1964) this Court gave further meaning to the supervisory mandamus concept. By an 8-to-1 majority, this Court upheld the Seventh Circuit's decision to review by writ of mandamus a district court's interpretation, and application, of Rule 35, Federal Rules of Civil Procedure. On the question of the propriety of invoking mandamus this Court held:

> That this issue was substantial is underscored by the fact that the challenged order requiring examination of a defendant appears to be the *first of its kind in any reported decision in the federal courts* under Rule 35, and we have found *only one such modern case in the state courts.* The Court of Appeals recognized that it had the *power to review* on a petition for mandamus the *basic, undecided question* of whether a district court could order the mental or physical examination of a defendant. We agree that, under these unusual circumstances and in light of the authorities, the Court of Appeals had such power.
>
> * * *
>
> The meaning of Rule 35's requirement of "in controversy" and "good cause" also raised issues of first impression. In our view, the Court of Appeals should have also, under these special circumstances, determined the "good cause" issue, so as to avoid

> piecemeal litigation and *to settle new and important problems.*
> (emphasis added; footnotes omitted) 379 U.S. at 110-11.[14]

The Courts of Appeals that have tried to implement this Court's decisions in *La Buy* and *Schlagenhauf* have concluded that difficult, unresolved questions of law are precisely the questions that should be reviewed under the court's supervisory mandamus powers. To those courts—when a pure question of law is involved—existence of a plausible argument on each side of the question, or a conflict in the lower courts, militates in favor of, not against, use of the mandamus power.[15]

What the CCPA held in this action is precisely the opposite. It held that it had no power to consider on the merits, much less the discretion to grant, a mandamus petition once it became clear that lawyers could disagree on the merits of the dispute. While such a test may have its place when a mandamus petition turns on matters of judicial discretion, that test makes no sense when the question is one of pure law.

The CCPA's conclusion in this action is inconsistent with the decisions by this Court in *La Buy* and *Schlagenhauf,* is

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14. Will v. United States, 389 U.S. 90 (1967), has been read by some commentators as restricting *Schlagenhauf,* 9 Moore's Federal Practice, *supra* ¶ 110.28 at 308, while it is read by others as a decision on the facts and thus largely irrelevant to this controversy. *See* 16 Wright & Miller, Federal Practice and Procedure, *supra* § 3934 at 233-35, and Hart and Wechsler's The Federal Courts and the Federal System, *supra* at 1570-71. Whether *Will* can be fairly dismissed here because it was a criminal case in which no adequate record was presented in the Court of Appeals is, obviously, a matter of debate. Nonetheless, there can be no basis for arguing that *Will* sanctions the extremely restrictive standard used by the CCPA in this action.

15. United States v. United States District Court, 444 F.2d 651 (6th Cir. 1971), *aff'd,* 407 U.S. 297 (1972), quoted at page 13, above; United States v. DiRusso, 548 F.2d 372, 374 (1st Cir. 1976); *see also* the cases cited in Points II B and C, above.

in clear conflict with the decisions of at least five other circuits, and is, as well, an effective abdication of the CCPA's responsibility to supervise the TTAB and the Customs Court. That result cannot, petitioner submits, be squared with this Court's view—articulated in *La Buy* and *Schlagenhauf*— that writs of mandamus and prohibition should be judiciously used to lead, supervise and otherwise aid the lower courts.

Conclusion

WHEREFORE, petitioner Formica Corporation respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Customs and Patent Appeals entered in this proceeding on January 25, 1979.

March 26, 1979

Respectfully submitted,

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APPENDIX

United States Court of Customs and Patent Appeals

Appeal No. 79-526.

Cancellation No. 11,955.

DECIDED: January 25, 1979

FORMICA CORPORATION,

Petitioner

v.

SAUL F. LEFKOWITZ, DAVID KERA, and JANET E. RICE, Members, Patent and Trademark Office Trademark Trial and Appeal Board,

AND

FEDERAL TRADE COMMISSION, Petitioner in Cancellation Proceeding No. 11,955,

Respondents.

ON PETITION FOR WRITS OF MANDAMUS AND PROHIBITION

Before MARKEY, Chief Judge, RICH, BALDWIN, LANE, and MILLER, Associate Judges.

RICH, Judge.

The basic proceeding to which the present matter relates is a trademark cancellation proceeding, No. 11,955, in the United States Patent and Trademark Office (PTO).[1] The

1. *Federal Trade Commission* v. *Formica Corp.*, 200 USPQ 182 (TTAB 1978).

trademark is FORMICA and the cancellation petitioner is the Federal Trade Commission (FTC). The FTC's petition was filed May 31, 1978. The respondent therein is Formica Corporation, owner of the mark and of its certificate of registration, No. 421,496, under the Trademark Act of February 20, 1905, registered June 4, 1946.[2] The mark was republished, with the prescribed affidavits, under § 12 (c) of the Trademark Act of 1946 (15 USC 1062(c)) on May 11, 1948, in the Official Gazette of the then Patent Office.

The matter now before this court is a petition for writs of mandamus and prohibition arising from the following situation.

In the aforesaid cancellation proceeding before the PTO Trademark Trial and Appeal Board (TTAB), Formica Corporation moved to dismiss FTC's petition to cancel, according to the TTAB opinion, "on the ground 'that the FTC is without statutory authority to bring the instant cancellation proceeding'." The statute involved on the point of the FTC's authority is the proviso of section 14 of the 1946 Act as amended by Public Law 87-772, 76 Stat. 769, Oct. 9, 1962, which section reads in pertinent part:

> *Sec. 14 (15 U.S.C. 1064). Cancellation of registrations*
>
> A verified petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed by any person who believes that he is or will be damaged by the

2. The registration was amended Aug. 30, 1966, in that the drawing was changed to show the mark in plain block letters instead of letters incorporating a design. The registration has been maintained by the filing of the affidavits required by sections 8 and 15 of the 1946 act (15 USC 1058 and 1065) and by timely renewal for a second term of 20 years, running from June 4, 1966.

> registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905—
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> * * * *
>
> (c) at any time if the registered mark *becomes the common descriptive name of an article or substance,* or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 or of subsection (a), (b), or (c) of section 2 of this Act for a registration hereunder, or contrary to similar prohibitory provisions of said prior Acts for a registration thereunder, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services in connection with which the mark is used; * * *
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> * * * *
>
> *Provided*, That the Federal Trade Commission may apply to cancel on the grounds specified in subsections (c) and (e) of this section any mark registered on the principal register established by this Act, and the prescribed fee shall not be required. [Emphasis ours. Subsection (e) is not here involved.]

The FTC relies on the above proviso as its authorization to petition to cancel the registration of FORMICA and the ground asserted for cancellation is the one emphasized in paragraph (c), that FORMICA has become the common descriptive name of an article or substance.[3]

The statutory ground on which Formica Corporation based its motion before the TTAB to dismiss the petition

3. We assume it to be the intent of the drafters of the statute to say that the mark has become the common descriptive name of some article or substance *for which it was registered,* not just any article or substance. The goods named in the registration certificate sought to be cancelled are: "Laminated sheets of wood, fabric, or paper impregnated with synthetic resin and consolidated under heat and pressure, for use on table tops, furniture and wall panelling."

was that its registration of FORMICA under the 1905 Act, though republished in accordance with § 12(c) of the 1946 Act, does not conform to the words of the proviso, "any mark registered on the principal register established by this Act," meaning the 1946 Act. Wherefore, Formica Corporation contended, the FTC is not authorized to proceed against its registration.[4] The FTC strongly urged before the TTAB that republication under § 12(c) of the 1946 Act caused FORMICA to become a "mark registered on the principal register" created by the 1946 Act.

In an opinion of November 8, 1978, supporting its denial of the motion to dismiss the cancellation petition, the TTAB, after extensive briefing and oral argument, agreed with the position of the FTC. The board held: "A mark [registered under the 1905 Act] which is republished is thenceforth as much on the Principal Register as though it had been originally registered thereon." In denying the motion to dismiss, the TTAB gave the respondent until December 8, 1978, to file an answer and set a pre-trial conference for December 15, 1978.

4. With typical Lanham Act ineptitude, the proviso of §14 speaks of applying "to cancel * * * any mark" although the opening of the same section speaks of a "petition to cancel a registration." Here again we shall assume that the drafters of the proviso intended to authorize the FTC to petition to cancel certain *registrations,* which is another way of saying to *remove* marks from the principal register, which register, we understand, is merely a figment of legal imagination—a label imprinted on certificates of registration to indicate what statutory legal consequences shall attach to the act of registering, there being two kinds of registration under the statute with different legal consequences. We can visualize no way in which a *trademark*—even when it has ceased to *be* a trademark by becoming a generic name—can be "cancelled." Since registration does not create trademarks, which must preexist to be registrable, it follows that removal from the register does not "cancel" them. *See* 1 J. McCarthy, *Trademarks and Unfair Competition* § 20:17(c) at 799 (1973) and cases cited.

Formica Corporation, after denial of its motion to dismiss, filed in this court on November 22, 1978, the petition for writs of mandamus and prohibition "ordering the TTAB (a) to vacate its Opinion and Order of November 8, 1978, and (b) to dismiss Cancellation Proceeding No. 11955 for lack of jurisdiction on the ground that the FTC does not have statutory authority to bring such proceeding."

As shown by the heading of this opinion, the members of the TTAB who rendered the decision denying the motion to dismiss were made respondents along with the FTC.

November 27, 1978, Formica Corporation obtained from the TTAB a suspension of all proceedings, including its time to answer and the pre-trial conference, pending the outcome of the present petition for mandamus.

The FTC has responded to the petition for mandamus by filing a motion to dismiss that petition on the ground that this court lacks jurisdiction to grant the writs by reason of an interesting ploy on the part of the FTC, which proceeds as follows. The petition, says the FTC, "is the equivalent of an appeal from a decision of the TTAB and should be governed by Section 21 of the Lanham Act, 15 U.S.C. § 1071, the statutory provision for appeals from TTAB decisions." (A footnote to that statement says: "The FTC, of course, does not concede that an interlocutory appeal from the TTAB's decision would be appropriate.") Under section 21, as is well understood, one dissatisfied with a "decision" of the TTAB in a cancellation proceeding has the option of appealing to this court or of proceeding by way of a civil action under section 21(b); and, in an inter partes proceeding, if a dissatisfied party appeals to this court, an opponent may elect "to have all further proceedings conducted as provided in section 21(b)," by civil action in an appropriate district court. Treating this petition for mandamus as an appeal within the meaning of the

statute, the FTC filed a notice of election in the PTO simultaneously with the filing of its motion to dismiss the petition for mandamus in this court, on which basis it urges that "this *de facto* appeal should be dismissed." Its theory is that when such a notice of election is filed, this court *must* dismiss any appeal lodged before it and, since the petition is a de facto appeal, we must dismiss it because we have been deprived of jurisdiction. The FTC has also taken a further step. An affidavit of the Secretary of the FTC dated December 11, 1978, states:

> On December 8, 1978, the Commission *determined* that, in the event of any further appeal of a decision of the Trademark Trial and Appeal Board in Cancellation Proceeding No. 11955, the Commission *will elect* to have all further proceedings conducted in a civil action as provided in 15 U.S.C. § 1071(b). [Emphasis ours.]

Combining its present purported actual election and its "determination" to always elect in the future, the FTC says that this court has no present or prospective jurisdiction over this cancellation proceeding in aid of which we could possibly issue a writ of mandamus and therefore we have no jurisdiction of this petition under the All Writs Act, 28 USC 1651(a), under which Formica Corporation has purported to file its petition for the writs.

The PTO Solicitor, acting as counsel for the three TTAB members who denied the motion to dismiss, has also filed a motion to dismiss the petition now before us. The position taken is that taken by the FTC, that in view of the present election and promise of future election to take review away from this court, we are without "jurisdiction over the subject matter of the PETITION and therefore the PETITION must be dismissed."

Formica Corporation, responding to both motions to dismiss, attacks the underlying basis of the contention of the FTC and the PTO that this court is without jurisdiction to pass on the petition for mandamus, asserting that the purported election to have this and all further proceedings by way of a civil action is a nullity. The reasoning is that the TTAB has not yet rendered any "decision" which could be appealed to this court,[5] that section 21 of the Trademark Act (15 USC 1071) pertaining to appeal and review by civil action is therefore inapplicable, that there has not been an appeal, and therefore the FTC cannot make an election under the statute and its notice of election is a nullity. Furthermore, the FTC's December 8th "determination" to elect in the future is no more than a statement of present intent, is not binding on it, and, therefore, is not an act which destroys this court's jurisdiction.

OPINION

The Motions to Dismiss

We believe the present effort to deprive this court of jurisdiction even to consider a petition for a writ of mandamus and/or prohibition through the device of the notice of election the FTC has filed under § 21 (15 USC 1071) presents a question of first impression. Obviously, we must deal with it before we consider the petition.

We agree with petitioner here, Formica Corporation, that the notice of election filed with the PTO is of no effect—that

5. No party to this proceeding has suggested that the TTAB's interlocutory decision denying Formica Corporation's motion to dismiss is an *appealable* decision, under section 21 or otherwise. It would appear that Formica Corporation filed the petition for mandamus, etc., presently before us because it thought the board's denial of its motion to dismiss was not appealable.

it is a nullity. The simple reason is that this is not an appeal in connection with which the election under § 21 may be made; it is a petition for extraordinary relief. The FTC's assertion that this petition is really an appeal is tantamount to a suggestion that Formica Corporation *could have* appealed under this court's interpretation of the so-called "final judgment" rule, *see Stabilisierungsfonds Für Wein* v. *Zimmermann-Graeff KG,* 198 USPQ 154 (CCPA 1978), and that we should treat it as an appeal. The fact is, however, that Formica Corporation chose not to appeal, and we therefore express no opinion concerning whether such an appeal, had it been taken, would be entertained by this court at this time. Formica Corporation has asked this court for a writ of mandamus or prohibition, and we must decide whether or not to grant the requested writ, not whether Formica Corporation *should* or *could* have appealed instead. We will not, as the FTC requests, treat the petition before us, under the circumstances of this case, as something which it is not. Formica chose to apply for the writ and the parties must take all that comes with such an application; the small likelihood that it will be granted and the inability of the FTC to elect under § 21 are included in this baggage. We will not rewrite Formica Corporation's petition for the convenience of the FTC.

No appeal having been taken, the FTC has no statutory right to make an election to have all further proceedings by civil action under § 21(b). In the absence of such a right, the purported notice of election the FTC has filed in the PTO, being unauthorized, is, as petitioner contends, a nullity.

The FTC's other maneuver—its alleged internal "determination" in the future always to elect a civil action in the event of any true appeal to this court in this cancellation proceeding—is equally ineffective. At best, it is a

mere expression of intent and not an act that can have any legal effect. The "determination" is not binding on the FTC, which could change its mind tomorrow; or the make-up of the FTC could change and result in a different view of what it should do.[6] We continue to have *potential* jurisdiction over a true appeal from an appealable decision of the TTAB in this cancellation proceeding. That potential jurisdiction cannot be taken away until after it has attached by the taking of an appeal. *See Duffy* v. *Tegtmeyer,* 489 F.2d 745, 180 USPQ 317 (CCPA 1974).

Since we see no merit in the FTC and PTO motions to dismiss for lack of this court's jurisdiction to consider the petition for the writs requested, we turn now to the question whether this is a proper case in which to issue them.

The Requested Writs

It is settled law that this court has the discretionary power to issue writs of mandamus and prohibition under the All Writs Act, 28 USC 1651. *Loshbough* v. *Allen,* 56 CCPA 914, 404 F.2d 1400, 160 USPQ 204 (1966). *See also Weil* v. *Dann,* 503 F.2d 562, 183 USPQ 300 (CCPA 1974);

6. The carrying out of its "determination" for the future is not altogether in the hands of the FTC. The proposal has already been floated in government circles that the alternate remedy of review by civil action be abolished as superfluous. At some future date it might not be possible to escape this court's jurisdiction by that route. In any event, it seems somewhat strange (unless it be regarded as the sheer fun of playing legal games) that the FTC should deem it preferable to take *a pure question of law involving no disputed facts*—and that is what this petition for mandamus involves—to a judge of a busy district court by the civil action election route rather than leaving it with a five-judge appellate court which always sits en banc. Which is the preferred tribunal for settling a question of law? The theoretical justification of the trial de novo is to provide for receiving evidence of *facts,* not settling the law. Game playing at the expense of the judiciary cannot be too strongly disapproved.

Duffy v. *Tegtmeyer,* supra. However, we do not regard the issuance of either writ to be appropriate or necessary in this case, for the reasons hereinafter stated.

While it is true that we do not presently have appellate jurisdiction of this case, apart from the petition before us, we have noted above our prospective jurisdiction which is sufficient for the purposes of the All Writs Act. *See Roche* v. *Evaporated Milk Assoc.,* 319 U.S. 21, 25 (1943). Even so, we may not grant the requested writs unless doing so is "agreeable to the usages and principles of law." 28 USC 1651(a). In this respect, we have guidance from the Supreme Court, which stated in *Roche,* supra at 26:

> The traditional use of the writ in aid of appellate jurisdiction both at common law and in the federal courts has been to confine an inferior court to a lawful exercise of its prescribed jurisdiciton or to compel it to exercise its authority when it is its duty to do so.

See also, Thermtron Products, Inc. v. *Hermansdorfer,* 423 U.S. 336, 352 (1976).

It is Formica Corporation's contention that the FTC is not authorized by § 14 of the 1946 Trademark Act (15 USC 1064) to bring a cancellation proceeding against a 1905 Act registration which has been republished under § 12(c) of the 1946 Act (15 USC 1062(c)). In essence, the argument is that the FTC lacks standing to initiate the cancellation proceeding, wherefore the TTAB lacks the power to hear this case.

While such an argument is sometimes referred to as directed toward lack of "jurisdiction" in the TTAB to hear the case, the inclusion of an improper party or the nonexistence of a proper petitioner is not a jurisdictional

defect in the traditional sense.[7] However, lack of standing has been thought of as related to jurisdictional defects and, if proven, an adequate basis for dismissal on appeal for want of a justiciable controversy, which justiciable controversy is a sine qua non for the exercise of Article III judicial power. *Cf. Sierra Club* v. *Morton,* 405 U.S. 727 (1972); *Frothingham* v. *Mellon,* 262 U.S. 447 (1923).

This, however, is not an appeal. The question before us is whether or not Formica Corporation has established a proper case for the remedy it seeks. "[W]hile a function of mandamus in aid of appellate jurisdiction is to remove obstacles to appeal, it may not appropriately be used merely as a substitute for the appeal procedure prescribed by statute." *Roche,* supra at 26. This is particularly true, where, as here, the issue involves "jurisdictional questions which [the TTAB] was competent to decide and which are reviewable in the regular course of appeal." *Id.; accord, Alkali Export Assoc.* v. *United States,* 325 U.S. 196, 202-03 (1945). This court has refused to grant the writ where it is sought as a vehicle for review of routine interlocutory orders and where effective relief is available in the regular course of appeal. We recognize that "The necessity of orderly procedure and the husbanding of judicial time and effort often require litigants to undergo costs and inconvenience which might be avoided by interlocutory review." *Weil* v. *Dann,* supra, 503 F.2d at 563, 183 USPQ at 300.

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7. There can be no question that the TTAB has ***subject matter jurisdiction*** over cancellation proceedings, 15 USC 1067, and neither party has asserted insufficient notice or other violation of due process which would invalidate ***personal jurisdiction*** of the TTAB over the parties. The problem of standing, however, is a concept related to jurisdiction. *See U. S. ex rel. Chapman* v. *Federal Power Commission,* 345 U.S. 153 (1953); C. Wright, *Law of Federal Courts* §13 at 42-52 (3d Ed. 1976). If the cancellation petitioner has no standing, the cancellation proceeding must be dismissed, in which sense the TTAB loses "jurisdiction" over the matter.

As we said in *Stabilisierungsfonds,* supra, "If the parties could take up on appeal each disputed ruling by the TTAB as it was handed down, an inter partes proceeding could drag on indefinitely."

In deciding whether to grant mandamus, we must recognize the extraordinary nature of the relief requested. "Though the power is curative, it is strong medicine and its use must therefore be restricted to the most serious and critical ills." *United States* v. *Boe,* 64 CCPA 11, 19, C.A.D. 1177, 543 F.2d 151, 157-58 (1976). In considering the application of this principle to the present case, we note the test enunciated in *American Airlines, Inc.* v. *Forman,* 204 F.2d 230, 232 (1953), by the Third Circuit, for cases where mandamus is sought to correct the allegedly wrongful assumption of jurisdiction, which appears to us to be particularly suited to this situation:

> The challenged assumption or denial of jurisdiction must be so plainly wrong as to indicate failure to comprehend or refusal to be guided by unambiguous provisions of a statute or settled common law doctrine. *If a rational and substantial legal argument can be made in support of the questionable jurisdictional ruling, the case is not appropriate for mandamus* * * * even though on normal appeal a court might find reversible error. [Emphasis ours.]

Accord, Ex parte Chicago, Rock Island & Pacific Railway Co., 255 U.S. 273 (1921); *American Fire Insurance Co.* v. *U.S. District Court,* 538 F.2d 1371 (9th Cir. 1976); *Pfizer* v. *Lord,* 522 F.2d 612, 615 (8th Cir. 1975), *cert. denied,* 424 U.S. 950 (1976). Our decision in *United States* v. *Boe,* supra, is consistent with this approach, which we now expressly adopt.

Applying this test to the case before us, clearly this is not a proper case for mandamus. Our research reveals

that, at the time of the hearing on Formica Corporation's motion to dismiss, there was some indication that Formica Corporation's republished 1905 Act registration should be considered as one of a mark "registered on the principal register established by this Act" (the Lanham Act) and thus subject to the proviso. In her "Commentary on the Lanham Trademark Act," printed in the 1948 edition of Title 15 USCA §§ 81-1113, Daphne Robert (a participant in the drafting of the Lanham Act and later Assistant Commissioner Daphne Leeds and as such the predecessor of the TTAB) asserted that a republished registration "is for all purposes *a registration on the principal register and is subject to all provisions of the new Act as if it had been originally registered under that Act.*" (Emphasis ours.) Title 15, USCA §§ 81-1113 at 276 (1948). Particularly, with respect to the authority of the FTC to petition to cancel republished registrations, she commented: "the Federal Trade Commission may not apply to cancel such registrations until they become principal registrations by virtue of [republication]." *Id.* at 283. On the other hand, the only decision on the point, *Federal Trade Commission* v. *Elder Manufacturing Co.,* 84 USPQ 429 (Comm'r 1950), had held that the FTC had no standing to petition to cancel any registration obtained under a previous trademark act, *whether or not republished.* To add to the confusion, one commentator has cited the *Elder* case for the proposition that the FTC can act against a pre-Lanham Act registration only *if it has been republished. See* Vandenburgh, *Trademark Law and Procedure,* § 10.90 at 463 n. 4 (2d ed. 1968). No court has ever passed on this issue.

Furthermore, we have carefully considered Formica Corporation's arguments and supporting documents based on legislative history but do not find in the striking and reenactment of § 14, section 9 of Pub. L. No. 87-772, 76

Stat. 769 (1962), or the contemporaneous events surrounding its reenactment, *see* S. Rep. No. 2107, 87th Cong., 2d Sess., *reprinted in* U. S. Code Cong. & Ad. News, 87th Cong., 2d Sess., 2844-57 (1962), a clear indication of legislative intent regarding the meaning of the proviso here at issue. In response to the suggestion of the FTC that *Elder* should be legislatively overruled, the committee stated in its report:

> The committee does not think it appropriate to consider changes of this nature at this time, since the instant bill is in large part a housekeeping measure, making minimal substantive changes in the trademark law. The Federal Trade Commission's suggestions, on the other hand, would bring about a substantive change in policy. In addition, the committee has been advised that there is no present need for this particular change.

U. S. Code Cong. & Ad. News, supra, at 2485. Even the committee's report is not without ambiguity; it is not entirely clear which of the FTC's suggestions the committee found unnecessary. Of the two suggestions offered by the FTC with respect to § 14, the committee is here responding to one, which is unspecified. The *Elder* decision was a single isolated event by a single Commissioner of Patents and cannot be considered as representative of an accepted administrative practice.

Where, as here, the law at the time of the hearing on Formica Corporation's motion was in such an unsettled state, the issue was definitely one for which "a rational and substantial legal argument [could have been] made" in support of either position. We cannot fault the TTAB for deciding the motion to dismiss as it did under these circumstances. For ourselves, we express no opinion at this

time on the correctness of the view that the registration of FORMICA must be considered as one on the principal register, or of the jurisdictional ruling (the denial of the motion to dismiss the cancellation proceeding); we merely hold that the requested writs should not issue in this case.

Decision

The motions to dismiss the petition of Formica Corporation for writs of mandamus and prohibition, filed by the FTC and on behalf of the members of the Trademark Trial and Appeal Board, are *denied.*

Formica Corporation's petition for writs of mandamus and prohibition is *denied.*

Motions for extensions of time to file briefs on the merits are *denied* as moot.

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Thursday, January 25, 1979

Before: Markey, Chief Judge, Rich, Baldwin, Lane and Miller Associate Judges and Judge Ford, United States Customs Court.

ACTION IN PENDING CASE

No. 79-526. FORMICA CORPORATION, Petitioner v. SAUL F. LEFKOWITZ, DAVID KERA, and JANET E. RICE, Members, Patent and Trademark Office Trademark Trial and Appeal Board, and FEDERAL TRADE COMMISSION, Respondents. The motions of respondents to dismiss the petition of Formica Corporation for Writs of Mandamus and Prohibition are *denied.* The Petition for Writs of Mandamus and Prohibition is *denied.* Respondents motions for extension of time to file briefs on the merits are *denied* as moot. Opinion by Rich, Judge.